

05-31-05

AP
IPW



PATENT APPLICATION
Attorney Docket No. WHT-1

Certificate of Express Mailing

I hereby certify that this correspondence (Letter and Appeal Brief) is being deposited with the United States Postal Service using "Express Mail Post Office to Addressee" service under 37 CFR 1.10, on February 14, 2005, and is addressed to the Board of Patent Appeals and Interferences, United States Patent and Trademark Office, PO Box 1450, Alexandria, Virginia 22313-1450.

Date

5/27/2005

Express Mail Label No.

EV610026335US

Duane C. Basch Reg. 34,545

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES**

Inventor: **William H. Tew III**
Application No.: **09/996,707**
Filed: **November 30, 2001**
Title: **Produce Handling Material**

Conf. No.: **3674**
Group Art Unit: **1744**
Examiner: **Mark Spisich**

Mail Stop **Appeal Brief - Patents**
Honorable Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

**LETTER ACCOMPANYING SUPPLEMENTAL APPEAL BRIEF
&
COPY OF POWER OF ATTORNEY / CORRESPONDENCE ADDRESS**

In response to the Notification of Non-Compliant Appeal Brief dated April 28, 2005, Appellant submits herewith a Supplemental Brief on Appeal in the above-identified

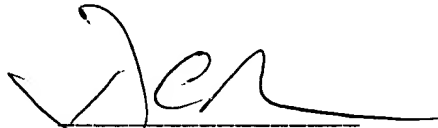
application. This Brief corrects the various errors noted by the Examiner in the previous submission.

No oral hearing is requested.

Applicant further notes that in spite of a Power of Attorney & Correspondence Address change submitted in October 2003 (*copy attached – 2 pages*), communications for the instant application continue to be sent to the undersigned attorney's former practice address. The undersigned attorney respectfully requests that the Patent Office acknowledge the attached copy of the Power of Attorney and send all subsequent correspondence to the address associated with Customer Number 37211 so as to avoid further delays in communications relative to this application.

In the event that any additional fees are required as a result of this submission, including any extensions of time, authorization is hereby provided to charge such fees or additional amounts to the Basch & Nickerson LLP Deposit Account 50-2737.

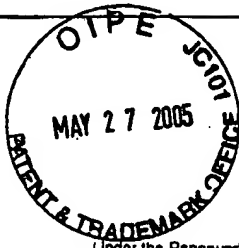
Respectfully submitted,

A handwritten signature in black ink, appearing to read 'DCB', with a long horizontal flourish extending to the right.

Duane C. Basch
Attorney for Appellant
Registration No. 34,545

Basch & Nickerson LLP
1777 Penfield Road
Penfield, New York 14526
(585) 899-3970

DCB/ *qcb*



FILE COPY

PTO/SB/92 (05-03)
Approved for use through 04/30/2003. OMB 0561-0031
Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

Certificate of Mailing under 37 CFR 1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

on 10/21/2003
Date

Der
Signature

Duane C. Basch # 34,545
Typed or printed name of person signing Certificate

Note: Each paper must have its own certificate of mailing, or this certificate must identify each submitted paper.

The following papers listed below are submitted [WHT-1 09/996,707]:

Certificate of Mailing

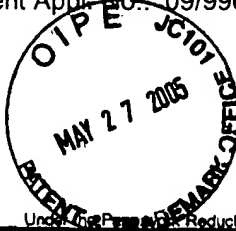
Power of Attorney and Correspondence Address Indication Form

Return Postcard

If any additional fees are due, please charge to Deposit Account 50-2737.

This collection of information is required by 37 CFR 1.8. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 1.8 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden should be sent to the Chief Information Officer U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

**FILE COPY**

Approved for use through 11/30/2005. OMB 0651-0035
 U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
 Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**POWER OF ATTORNEY
 and
 CORRESPONDENCE ADDRESS
 INDICATION FORM**

Application Number	09/996,707
Filing Date	November 30, 2001
First Named Inventor	William H. Tew III
Title	Improved Produce Handling Material
Art Unit	1732
Examiner Name	Mark Spisich
Attorney Docket Number	WHT-1

I hereby appoint:

☐ Practitioners at Customer Number:

OR

☒ Practitioner(s) named below:

Name	Registration Number
Duane C. Basch	34,545
Michael J. Nickerson	33,265

as my/our attorney(s) or agent(s) to prosecute the application identified above, and to transact all business in the United States Patent and Trademark Office connected therewith.

Please recognize or change the correspondence address for the above-identified application to:

☐ The above-mentioned Customer Number.

OR

☒ The address associated with Customer Number:

37211

OR

<input type="checkbox"/> Firm or Individual Name			
Address			
Address			
City	State	Zip	
Country			
Telephone	Fax		

I am the:

☒ Applicant/Inventor.

☐ Assignee of record of the entire interest. See 37 CFR 3.71.
 Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/98).
SIGNATURE of Applicant or Assignee of Record

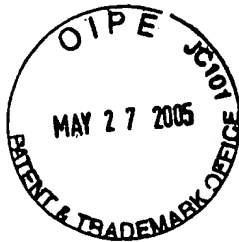
Name	William H. Tew III		
Signature			
Date	9-30-03	Telephone	(585) 585-6120

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

☒ Total of 1 forms are submitted.

This collection of information is required by 37 CFR 1.31 and 1.33. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 3 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



PATENT APPLICATION
Attorney Docket No. WHT-1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE

BOARD OF PATENT APPEALS AND INTERFERENCES

William H. Tew III - Appellant

Inventor: **William H. Tew III**
Application No.: **09/996,707**
Filed: **November 30, 2001**
Title: **Produce Handling Material**

Conf. No.: **3674**
Group Art Unit: **1744**
Examiner: **Mark Spisich**

APPELLANT'S BRIEF ON APPEAL

TABLE OF CONTENTS

	<u>PAGE</u>
TABLE OF CASES	3
1. REAL PARTY IN INTEREST	4
2. RELATED APPEALS AND INTERFERENCES	4
3. STATUS OF CLAIMS	4
4. STATUS OF AMENDMENTS	4
5. SUMMARY OF CLAIMED SUBJECT MATTER.....	4
6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL	8
7. ARGUMENT	9
8. CLAIMS APPENDIX	30
9. EVIDENCE APPENDIX	34
10. RELATED PROCEEDINGS APPENDIX	35



TABLE OF CASES

PAGE NO.

Moba, v. Diamond Amt'n, Inc., 66 USPQ2d 1429, 1438 (Fed. Cir. 2003).....	10
In re Tiffin and Erdman, 170 USPQ 88 (CCPA, 1971).....	12
In re Lintner, 173 USPQ 560, (CCPA, 1972)	12
Graham v. John Deere Co., 383 US 1 (US Sup. Ct., 1966).....	12
Panduit Corp. v. Dennison Mfg. Co., 1 USPQ2d 1593 (Fed. Cir., 1987).....	12
In re Mills, 16 USPQ2d 1430 (Fed. Cir. 1990)	12
In re Kamm et al., 172 USPQ 298(CCPA, 1972)	13, 22
In re Gordon, 221 USPQ 1125, (Fed. Cir., 1984)	13, 22, 23
Jones v. Hardy, 220 USPQ 1021, (Fed. Cir., 1984)	13, 22
In re Vaeck, 20 USPQ2d 1438 (Fed. Cir. 1991).....	13

1. **REAL PARTY IN INTEREST**

William H. Tew III

2. **RELATED APPEALS AND INTERFERENCES**

NONE.

3. **STATUS OF CLAIMS:**

Claims 1 – 19 and 22 - 26 remain rejected in the application. Claims 20 and 21 have been canceled. The rejection of claims 1 – 19 and 22 - 26 is appealed herein.

4. **STATUS OF AMENDMENTS:**

No amendment after Final Rejection was submitted. The claims stand as amended by right in Appellant's Amendment of July 26, 2004, prior to the Final Rejection.

5. **SUMMARY OF CLAIMED SUBJECT MATTER:**

As is noted page 1, lines 1-14 of the Specification, the instant invention is directed to improving the operability, maintenance and sanitary performance of produce-handling equipment. More specifically, the invention is directed to equipment that may be difficult to clean when the presence of water or liquid promotes the growth of bacteria and fungi. The present invention seeks to prevent such growth on elements of such produce handling equipment. Appellant's claimed subject matter is directed to a vegetative produce handling machine as more particularly set forth in claims 1 – 19 and 22 - 26.

Independent Claim 1: As set forth in claim 1, in part, the claimed invention is directed to a vegetative produce handling machine. The machine includes a vegetative produce receiver having a generally horizontal receiving surface as

depicted, for example, in Figures 1 – 2 (114, 116), and an adjacent vegetative produce washer 118 that is also depicted in the figures. Description of these elements is found, for example, at page 5 of the as-filed application. As recited in the claim, the vegetative produce is washed as it is transported through the washer. After leaving the vegetative produce washer, a water absorber 122 movably supports the produce while removing excess water present on the produce when it exits the washer (pages 5 – 6). In addition, the vegetative produce handling machine includes at least one stationary vegetative produce contacting surface (non-limiting examples at bottom of page 6) that is covered a foam padding, where the foam padding is intended to reduce bruising of the vegetative produce and is formed with an anti-microbial agent to retard the growth of microbes within the padding. Such a feature is not only described relative to Figure 1 at page 6 of the Specification, but is further characterized in detail at pages 8 – 9, which describe the padding embodiments of Figures 7 and 8.

Dependent Claims 2 - 5: Claim 2 is directed to the vegetative produce handling machine of claim 1, but further recites a water absorber 122 with donut-style rolls as depicted in Figures 4 and 6 (e.g., rolls 410, made of donuts 430) as described in detail at pages 7 – 8 of the Specification. Moreover, the claim further recites the limitation that the rolls are made from an open-cell foam having anti-microbial properties. Claim 3 sets forth the limitation that the open-cell foam of claim 2 is produced with anti-microbial properties by adding an anti-microbial agent during the manufacture of the foam as taught at page 7, lines 18-23.. Claim 4 recites the further limitation that the open-cell foam is latex foam as described at page 7, suitable for operating in a moist environment. Finally, claim 5 is dependent from claim 2, and is directed to additional details of the water absorber 122, reciting wringer rolls 414 as depicted in Figures 4 and 5.

Dependent claim 6: Claim 6 recites limitations that further define the nature of the foam padding covering at least one vegetative produce-contacting surface of the machine. The claim specifically recites that the foam is a closed-cell foam as described, for example, at pages 8 – 9.

Dependent Claim 7: Claim 7, dependent from claim 1, further includes the limitation that the foam padding covering at least one vegetative produce-contacting surface of the machine further includes a flexible outer layer of vinyl to reduce the absorption of moisture by the foam. Support for the limitations of claim 7 are found at page 9, lines 17 – 27. As to the recitation of the vinyl layer reducing the absorption of moisture, Appellant directs the Board's attention to page 1 of the Specification, particularly lines 20 – 27, where the correlation between abrasion (cutting and scraping) and the absorption of moisture that produces dark/damp surfaces prone to growth of bacteria and fungi is discussed.

Dependent claims 9 – 11: Claims 9 through 11 are directed to additional devices that may form part of a vegetative produce handling machine. Description of the roller inspection conveyor 130, the sizer(s) 140, 142, 144, and the packing table(s) 140A, 142A and 144A is found not only in Figures 1 and 2, but in the discussion at page 6 of the Specification as well.

Dependent Claims 12 – 14: Claims 12 – 14 are also dependent upon claim 1, and include further limitations associated with the vegetative produce washer recited in claim 1. In particular, claim 12 recites a drape produced with anti-microbial agents. Support for this limitation is found in the Specification at page 5, lines 20 – 25. Immediately following, at lines 25-28 is the description of the scrubber rubber (see also Figure 3) recited in claim 13. Lastly, claim 14 is directed to brushes 908 within the vegetative produce washer 118 as depicted in Figure 2 and in more detail in Figure 9 - where the brushes 908 have bristles 914 produced with an anti-microbial agent to provide resistance to the growth of microbes thereon.

Independent Claim 15: Claims 15 is also directed to a vegetative produce handling machine. In this case, however, the independent claim only recites a stationary vegetative produce-contacting surface, and foam padding covering at least a portion of the surface. Furthermore, the foam padding, which is formed with an anti-microbial agent to retard the growth of microbes, reduces

bruising of the vegetative produce contacting the surface. The machine includes, for example, a vegetative produce receiver having a stationary receiving surface as depicted in Figures 1 – 2 (114, 116). Other examples of stationary vegetative produce-contacting surfaces are found described at the bottom of page 6. The recited foam padding is intended, for example, to reduce bruising of the vegetative produce and is formed with an anti-microbial agent to retard the growth of microbes within the padding. Such a feature is not only described relative to Figure 1 at page 6 of the Specification, but is further characterized in detail at pages 8 – 9, which describe the padding embodiments of Figures 7 and 8.

Dependent Claim 16: Claim 16 recites the further limitation that the foam employed in the machine of claim 15 is a closed-cell foam. Support for this limitation is found at page 9 and relative to the descriptions of Figures 7 and 8.

Dependent Claims 17 - 19: Dependent claims 17 through 19 also depend from claim 15, and seek to further characterize the nature of the foam padding recited in claim 15. In particular, the flexible outer layer recited in claims 7 and 18 is depicted as layer 810 in Figure 8 and is described in detail at page 9, lines 17 – 27. The limitation of molding to shape is characterized at page 10 of the Specification, lines 11 – 14.

Dependent Claims 22 - 25: Claims 22 – 25 were added during prosecution of the instant application and are intentionally directed to further limitations of claims 1 and 3, reciting several of the alternative anti-microbial agents set forth in the Specification. In particular, the claimed agents are described at page 7, lines 24 through page 8, line 6.

Dependent Claim 26: Claim 26, dependent from claim 1, seeks to characterize the thickness of the foam padding as recited in claim 1. In particular, the limitation of at least 0.125 inches is set forth at page 9, line 4 in the description of Figure 7.

6. GROUND OF REJECTION TO BE REVIEWED ON APPEAL:

Claim 7 stands rejected under 35 U.S.C. §112, first paragraph.

Claims 15 and 19 stand rejected as being unpatentable under 35 U.S.C. §103(a) over the combination of Smith (2,635,267) in view of EITHER Zabron (5,906,269) OR JP6-246841.

Claims 15 and 19 stand rejected as being unpatentable under 35 U.S.C. §103(a) over the combination of Schnider (2,880,432) in view of EITHER Zabron (5,906,269) OR JP6-246841.

Claims 15 through 19 stand rejected as being unpatentable under 35 U.S.C. §103(a) over the combination of Ross (3,651,922) in view of EITHER Zabron (5,906,269) OR JP6-246841

Claims 15 through 19 stand rejected as being unpatentable under 35 U.S.C. §103(a) over the combination of Boyle (6,309,741) in view JP6-246841.

Claims 1, 6 – 11, 22, 24 and 26 stand rejected as being unpatentable under 35 U.S.C. §103(a) over the combination of Moore (2,195,371) in view of Ross (3,651,922) and further in view of EITHER Zabron (5,906,269) OR JP6-246841.

Claim 12 stands rejected as being unpatentable under 35 U.S.C. §103(a) over the combination of Moore (2,195,371) in view of Ross (3,651,922) and further in view of EITHER Zabron (5,906,269) OR JP6-246841 and further in view of Kurtz (3,242,008).

Claim 13 stands rejected as being unpatentable under 35 U.S.C. §103(a) over the combination of Moore (2,195,371) in view of Ross (3,651,922) and further in view of EITHER Zabron (5,906,269) OR JP6-246841 and further in view of Bowman (2,012,655).

Claim 14 stands rejected as being unpatentable under 35 U.S.C. §103(a) over the combination of Moore (2,195,371) in view of Ross (3,651,922) and further in view of EITHER Zabron (5,906,269) OR JP6-246841 and further in view of Butterworth (3,449,779).

Claims 2 – 5, 23 and 25 stand rejected as being unpatentable under 35 U.S.C. §103(a) over the combination of Moore (2,195,371) in view of Ross (3,651,922) and further in view of EITHER Zabron (5,906,269) OR JP6-246841 and further in view of Newhall (2,534,205).

7. ARGUMENT:

Several questions are presented in this appeal:

First, whether claim 7 is properly rejected under 35 U.S.C. §112, first paragraph?

Second, whether claims 15 and 19 are properly rejected as being unpatentable under 35 U.S.C. §103(a) over the combination of Smith (2,635,267) in view of EITHER Zabron (5,906,269) OR JP6-246841?

Third, whether claims 15 and 19 are properly rejected as being unpatentable under 35 U.S.C. §103(a) over the combination of Schnider (2,880,432) in view of EITHER Zabron (5,906,269) OR JP6-246841?

Fourth, whether claims 15 through 19 are properly rejected as being unpatentable under 35 U.S.C. §103(a) over the combination of Ross (3,651,922) in view of EITHER Zabron (5,906,269) OR JP6-246841?

Fifth, whether claims 15 through 19 are properly rejected as being unpatentable under 35 U.S.C. §103(a) over the combination of Boyle (6,309,741) in view JP6-246841?

Sixth, whether claims 1, 6 – 11, 22, 24 and 26 are properly rejected as being unpatentable under 35 U.S.C. §103(a) over the combination of Moore (2,195,371) in view of Ross (3,651,922) and further in view of EITHER Zabron (5,906,269) OR JP6-246841?

Seventh, whether claim 12 is properly rejected as being unpatentable under 35 U.S.C. §103(a) over the combination of Moore (2,195,371) in view of Ross (3,651,922) and further in view of EITHER Zabron (5,906,269) OR JP6-246841 and further in view of Kurtz (3,242,008)?

Eighth, whether claim 13 is properly rejected as being unpatentable under 35 U.S.C. §103(a) over the combination of Moore (2,195,371) in view of Ross (3,651,922) and further in view of EITHER Zabron (5,906,269) OR JP6-246841 and further in view of Bowman (2,012,655)?

Ninth, whether claim 14 is properly rejected as being unpatentable under 35 U.S.C. §103(a) over the combination of Moore (2,195,371) in view of Ross (3,651,922) and further in view of EITHER Zabron (5,906,269) OR JP6-246841 and further in view of Butterworth (3,449,779)? and

Tenth, whether claims 2 – 5, 23 and 25 are properly rejected as being unpatentable under 35 U.S.C. §103(a) over the combination of Moore (2,195,371) in view of Ross (3,651,922) and further in view of EITHER Zabron (5,906,269) OR JP6-246841 and further in view of Newhall (2,534,205)?

Rejection Under 35 U.S.C. §112, first paragraph (1st Question)

Considering, first, the most recent rejection of claim 7 under 35 U.S.C. §112, first paragraph (Final Action; Sept. 14, 2004), the rejection under §112, first paragraph requires that the Examiner establish that the rejected claim contains subject matter not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. See, e.g., *Moba, B.V. v. Diamond Automation, Inc.*, 66 USPQ2d 1429, 1438 (Fed. Cir. 2003).

As set forth in MPEP 2163.02, “[t]he subject matter of the claim need not be described literally (i.e., using the same terms or in *haec verba*) in order for the disclosure to satisfy the description requirement.” Rather, the test or analysis of description requirement and new matter issues is the same, and the Examiner’s burden of proof is to provide reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed. (MPEP 2163.04).

In light of the standard set forth in the MPEP, Appellant respectfully urges that a *prima facie* case of lack of written description has not been established, or at least that Appellant has met the requirement for written description as related to the function(s) of the recited vinyl layer. Appellant directs the Board's attention to page 1 of the Specification, lines 15 – 27 and more particularly lines 20 – 27 for support of the limitation of the vinyl layer reducing the absorption of moisture. There the Specification indicates "a closed or open-cell foam padding is cut or scraped in use, the cells or openings that are exposed provide dark/damp surfaces that are prone to the growth of bacteria and fungi," and clearly characterizes the correlation between abrasion of the foam padding (cutting and scraping) and the absorption or retention of moisture producing dark/damp surfaces. Combined with the stated problems of produce washing (liquid generated by or associated with washing allows any microbes associated with the produce to easily penetrate into seams, cracks, or other surfaces susceptible to the absorption or collection of liquids; lines 15-18), the Specification clearly establishes an aspect of the invention directed to reducing cracks, including those caused by abrasion. Moreover, page 9, lines 20-23 describe, "a flexible outer layer 810 that will withstand greater amounts of abrasion than the foam layer... made of vinyl or a similar material that will provide abrasion resistance," prone to growth of bacteria and fungi. As a result, Appellant respectfully submits that the relationship between abrasion resistance of a foam padding and water absorption/retention was well within his possession, and that the claimed limitation of "a flexible outer layer of vinyl to reduce the absorption of moisture by the foam padding" would have been understood by a person skilled in the art at the time the application was filed in view of the disclosure of the application. Claim 7 is, therefore, respectfully urged to meet the written description requirement of 35 U.S.C. §112, first paragraph, and the Board is urged to reverse the rejection thereof.

Rejection Under 35 U.S.C. §103 (2nd through 10th Questions)

Appellant respectfully submits that this invention is unique and has extensive application and utility. Under section 35 U. S. C. §103, the Patent and Trademark Office must make out a case of *prima facie* obviousness and it is incumbent upon Appellant to rebut that case with objective evidence of non-

obviousness, *In re Tiffin and Erdman*, 170 USPQ 88 (CCPA, 1971). In determining the propriety of the Patent and Trademark Office's case of *prima facie* obviousness, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed substitution, combination or other modification. The conclusion of *prima facie* obviousness may be rebutted and the claimed subject matter ultimately held to be legally non-obvious if there are differences between the patent application and the prior art's motivation for adding an element, or if the claimed subject matter has unexpectedly superior properties or advantages as compared to the prior art, *In re Lintner*, 173 USPQ 560, (CCPA, 1972).

It is well known that a determination of obviousness rests upon the answers to the factual inquiries set forth in *Graham v. John Deere Co.*, 383 US 1 (US Sup. Ct. 1966); scope and content of the prior art; differences between the prior art and the claims at issue; and level of ordinary skill in the art. In *Panduit Corp. v. Dennison Mfg. Co.*, 1 USPQ2d 1593 (Fed. Cir. 1987), the court stated that "[w]ith the involved facts determined, the decision maker confronts a ghost, i.e. "a person having ordinary skill in the art", not unlike the "reasonable man" and other ghosts in the law. To reach a proper conclusion under section 103, the decision maker must step backward in time and into the shoes worn by that "person" when the invention was unknown and just before it was made. In light of *all* the evidence, the decision maker must then determine whether the patent challenger has convincingly established, 35 U.S.C. 282, that the claimed invention as a whole would have been obvious at that time to that person. 35 U.S.C. §103. The answer to that question partakes more of the nature of law than of fact, for it is an ultimate conclusion based on a foundation formed of all the probative facts. If itself a fact, it would be part of its own foundation. . . . a prior patent must be considered in its entirety, i.e., as a *whole*, including portions that would lead away from the invention in suit." The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990). Although a prior art device "may be capable of being

modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." *Id. at 1432.*

Finally, the Examiner may not use the Appellant's disclosure as a recipe for selecting portions of the "prior art" to construct Appellant's claimed invention. A piecemeal reconstruction of the prior art patents in light of Appellant's disclosure is not a basis for a holding of obviousness, *In re Kamm et al.*, 172 USPQ 298 (CCPA, 1972). The mere fact that the prior art could have been modified does not make the modification obvious unless the prior art suggested the desirability of such a modification, *In re Gordon*, 221 USPQ 1125, (Fed. Cir. 1984); *Jones v. Hardy*, 220 USPQ 1021, (Fed. Cir. 1984). Moreover, this teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on the Appellant's disclosure. *In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991).

As a prefatory comment, Appellant wishes to note that the Examiner has urged the Appellant to have argued the references by themselves. Appellant has indeed, both in the prior responses and in the arguments set forth below, set forth the teachings of the references independently, and in combination, in order to properly characterize the nature of the teachings and what they might reasonably suggest to one of ordinary skill in the art. Appellant also urges that the Examiner's reliance on current knowledge (particularly to his broad characterization of knowledge at the top of page 10 (Final Action, p. 10, lines 1-3)) is troubling in that it not only sets forth an improper time at which the consideration of obviousness is made, but alludes to teachings that are not of record in the present application. Accordingly, Appellant has, in the following arguments, sought to set forth what might reasonably be suggested by the references relied upon.

Claims 15 and 19 (2nd Question)

Claims 15 and 19 were rejected under 35 U.S.C 103(a) as being unpatentable over the combination of Smith (2,635,267) in view of EITHER Zabron (5,906,269) OR JP6-246841. Smith is specifically directed to a machine "[t]o

economically and efficiently clean eggs without the danger for of injuring the air cells or breaking the egg.” (Col 1 Line 3-5) While Smith does suggest foam rubber on certain surfaces, it does not teach or suggest the need to prevent the growth of bacteria, fungi or the like, or that the egg cleaning machine is capable of cleaning vegetative produce as recited in the rejected claims. Appellant further notes that the brushing treatment taught by Smith would appear to cause damage to the vegetative produce now set forth in the claims.

Appellant further notes that molded-to-shape padding limitation, as expressly recited in claim 19, is employed to characterize the nature of the padding that reduces or eliminates seams that would aid the collection of moisture and encourage growth of bacteria, etc. Furthermore, as identified by the Examiner, Smith lacks any reference or suggestion to a problem with the growth of bacteria on any of the padded surfaces. Appellant further notes that Smith also fails to teach or suggest any motivation to consider the use of antimicrobial agents.

Zabron teaches construction of a multilayer conveyor belting material consisting of a belt having two woven scrims connected by the entanglement of staple fibers and needled binding members. The entire web is then encapsulated with an elastomeric material (e.g., yarn) to strengthen the connection between the scrims. Although Zabron does suggest the use of an anti-microbial material in a conveyor belt, it lacks any teaching or suggestion of the use of such a belt as a padding to mitigate the bruising of fruits and vegetables. Nor is there any reference to the washing of produce in conjunction with the conveyor belting.

The rejection fails to set forth where the specific suggestion is found to combine the conveyor of Zabron with the machine of Smith. The only mention of a belt in Smith is a drive belt from motor to brush assembly. Absent a specific suggestion to combine, even to suggest that the anti-bacterial conveyor materials would be applicable to an egg cleaning machine, there is no basis for the proposed combination, nor the Examiner's proposed modification of Smith. Appellant contends that to apply the teachings of

Zabron to materials other than the conveyor belting is an improper expansion of the scope of the Zabron teachings without a basis for such expansion – keeping in mind that a hindsight reconstruction of recited claim elements is not an adequate basis to support such an expansion. Moreover, the mere fact that references can be combined or modified does not render the resultant combination obvious absent a suggestion of the desirability of the combination (i.e., where it is suggested that it is desirable to incorporate an antimicrobial agent “into any surface of a machine”; Final Action, p. 4) Accordingly, Appellant respectfully contends that *prima facie* obviousness has not been established and that the rejection of claims 15 and 19 improper.

Even considering, *in arguendo*, a combination of Smith and Zabron, the combination fails to teach a vegetative produce handling machine with a stationary vegetative produce handling surface. Nor is there a teaching or suggestion of such a surface being covered with a foam padding to reduce bruising of the vegetative produce, where the padding material is formed with an anti-microbial agent.

With regard to the Japanese abstract #6246841, the description is directed to a solution of tin chloride, hydrochloric acid and an aqueous solution of silver nitrate into which a polyurethane foam material is subsequently dipped and rinsed. Appellant notes that the JP abstract does not suggest the use of the treated foam in contact with food articles of any type (notably, the suggested refrigerator use is only as a dust collecting material), and the reliance on the disclosed post-formation treatment as broadly suggesting any padding use is unsupported. Appellant further notes that the claims of the present invention recite a foam padding formed with an anti-microbial agent, which is also an improvement over surface or post-formation treatments. Thus, there is no suggestion of the use of the disclosed material as a padding in a vegetative produce handling machine. In light of the likely incompatibility between the material/treatment described in the JP abstract #6246841 and the proposed combination with Smith, Appellant respectfully asserts that *prima facie* obviousness has not been established.

Even considering the proposed combination of Smith and JP Abstract #6246841, *in arguendo*, this combination also fails to indicate use in a vegetative produce handling machine with a stationary vegetative produce handling surface. Nor is there a teaching or suggestion of such a surface being covered with a foam padding to reduce bruising of the vegetative produce, where the padding material is formed with an anti-microbial agent.

Appellant respectfully submits that the rejection is improper, or in the alternative, fails to teach all of the limitations of the claims as set forth. In view of the above, Appellant respectfully requests that the Board overturn the rejection of claims 15 and 19 under 35 U.S.C. 103(a) over the combination of Smith in view of EITHER Zabron or JP Abstract #6246841.

Claims 15 and 19 (3rd Question)

Claims 15 and 19 were improperly rejected as being unpatentable under 35 U.S.C. §103(a) over the combination of Schnider (2,880,432) in view of EITHER Zabron (5,906,269) OR JP6-246841. Schnider, like the Smith reference above, is directed to an egg cleaning machine. While Schnider does suggest padding on certain surfaces, Appellant urges that the brushing and handling taught by Schnider could damage vegetative produce so as to “teach away” from any reliance on such a disclosure. Furthermore, as acknowledged by the Examiner, Schnider lacks any reference or suggestion to the growth of bacteria or use of an anti-microbial agent on the padded surfaces. To apply the teachings Schnider to the handling of fruits and vegetables is expanding the scope of what is taught or suggested by Schnider.

Zabron, as noted previously, teaches construction of a multilayer conveyor belting material incorporating an anti-microbial material. However, Zabron lacks any teaching or suggestion of the use of the belting material as a padding to mitigate the bruising of fruits or vegetables. Nor is there any reference to the washing of produce in conjunction with the conveyor belting. In other words, Zabron lacks any suggestion of the use of the belting treated by the biocidal or biostatic compounds (col. 6, lines 44-49) as a padding.

Even considering the arguable combination of Schnider and Zabron, at best one of ordinary skill in the art would have been motivated only to substitute the Zabron conveyor material for that of the conveyor in Schnider. To do otherwise would require further suggestion not found in the references themselves. Such a combination still fails to describe a vegetative produce handling machine with a stationary vegetative produce handling surface. Nor is there a teaching or suggestion of such a surface being covered with a foam padding to reduce bruising of the vegetative produce, where the padding material is formed with an anti-microbial agent.

As noted above with regard to the combination based upon Japanese Abstract #6246841, the abstract is directed to treatment of a foam layer with a solution of tin chloride, hydrochloric acid and an aqueous solution of silver nitrate. However, the abstract does not suggest the use of the treated foam in contact with food articles of any type (refrigerator use is noted for a dust collecting material). Appellant further urges that the solutions suggested for treatment in the JP abstract would not be considered within the realm of acceptable materials for contact with food such as produce. In light of the apparent incompatibility between the treatment described in the abstract and the proposed combination with Schnider, Appellant respectfully contends that *prima facie* obviousness has not been established.

Even considering the proposed combination of Schnider and JP Abstract #6246841, *in arguendo*, at best the combination teaches the use of a biocidal agent in the yarns of the conveyor belting. Such a combination fails to teach a vegetative produce handling machine with a stationary vegetative produce handling surface covered with a foam padding to reduce bruising of produce, where the padding material is formed with an anti-microbial agent. In view of the above-noted arguments in traversal of the rejection of claims 15 and 19 under 35 U.S.C. 103(a) over Schnider in view of Zabron, or alternatively JP Abstract #6246841, Appellant respectfully urges that the rejection is improper or, in the alternative, fails to teach all of the recited limitations of claims claims 15 and 19. Accordingly, Appellant respectfully requests that the Board reverse the Examiner's rejection of claims 15 and 19 over the combination of

Schnider (2,880,432) in view of EITHER Zabron (5,906,269) OR JP #6246841.

Claims 15 through 19 (independently) (4th Question)

Claim 15

The fourth question presented the issue of whether claims 15 through 19 are properly rejected as being unpatentable under 35 U.S.C. §103(a) over the combination of Ross (3,651,922) in view of EITHER Zabron (5,906,269) OR JP6-246841. Ross teaches a live roller surface conveyor having pairs of rollers made of a resilient elastomeric foam whereby fruit is passed therebetween. Input to and output from the live-roller conveyor is provided by a belt conveyor 122 or similarly configured conveyors (e.g., 142, 145, 158). The conveyor is presented fruit from an infeed guide having a cushion arrangement to absorb the impact of the fruit entering the hopper. Ross identifies the live rollers as being constructed of an elastomeric foam, however in his teaching of the cushion (see col 6, lines 1-7) the Examiner has asserted that cushion 118 is constructed of the same material as rollers 84, as Ross fails to specifically disclose the material from which cushion 118 is constructed. Contrary to the Examiner's assertions, the disclosure at the top of col. 3 is clearly related to the live feed conveyor rollers, and is not necessarily suggestive of similar materials for the padding 118 mentioned at col. 6. Appellant respectfully notes, however, that a similar padding appears at the top of Figure 3, and a different fill pattern is employed in the illustration. Hence, Appellant respectfully urges that reliance on a similar fill pattern for shading of component cross-sections is without merit, or is ambiguous, as the basis for asserting the same material, and is at best indicative of a "sponge rubber" pad pursuant to MPEP drawing symbol patterns (which are not mandatory – see e.g., MPEP608.02).

Zabron, teaches a belt conveyor employing an anti-microbial material. However, as noted previously, Zabron lacks any teaching or suggestion of the use of the belt material as a padding to mitigate the bruising of fruits and vegetables. Furthermore, Zabron fails to make any suggestion of the use of a closed-cell foam with an antimicrobial agent as a stationary padding material.

To apply the teachings of Zabron to materials other than the belting is respectfully urged to be an improper expansion of the scope of the teachings without any basis to suggest such expansion.

Considering the combination of Ross and Zabron, at best one of ordinary skill in the art would have been motivated to substitute the Zabron conveyor material for that of the belt conveyors of Ross. Such a combination, however, fails to indicate a vegetative produce handling machine with a stationary vegetative produce handling surface. Nor is there a teaching or suggestion of such a surface being covered with a foam padding, where the padding material is formed with an anti-microbial agent as recited in the rejected claims. Nonetheless, the Examiner has indicated that Zabron somehow teaches the application of biocidal or biostatic materials applicable to all food-contacting surfaces, and uses this as the basis for "suggesting" the modification of the Ross padding. Absent a teaching or suggestion of this modification within the references themselves, Appellant urges that such a modification is unsupported and improper and urges the Board to reverse the rejection of claim 15 and all claims depending therefrom.

With regard to the Japanese Abstract #6246841, as noted above, the abstract is directed to a solution into which a foam material is dipped. Yet the JP abstract does not suggest the use of the treated foam in contact with food articles of any type and, therefore, would not be an obvious combination with the food handling machine of Ross. Appellant further urges that one of skill in the art would be disinclined to use the material or treatment described in JP Abstract as Ross clearly indicates the possibility of a wet environment and the described agents of the JP abstract all appear to be aqueously applied. As a result, one of skill in the art would not have been motivated to employ the teachings of the JP abstract. Hence, Appellant respectfully contends that *prima facie* obviousness has not been established, and requests that the rejection of claim 15, and claims depending therefrom, be reversed.

Claims 16, 17, 18

With respect to claim 16, neither Zabron nor Ross suggests what type of padding might be employed on a stationary surface, much less a closed-cell padding as claimed in 16. Claims 17 and 18, dependent from claim 15, also specifically recite further limitations not taught or suggested by any of the references or combinations relied upon. In particular, claim 17 further limits the foam padding by reciting that the padding "includes a continuous yet flexible outer layer." As the basis for teaching such a limitation, the Examiner relies on Ross, and the teaching of a "pliable wear sleeve 89" (col. 4, lines 54-55). However, reading of this description in context clearly shows the sleeve is an element depicted only with respect to the roller conveyor elements, and one which must be placed over the roller cores (otherwise discs would not be possible and no need to affix against axial movement; col. 4, lines 43, 58-60). Nor is the outer sleeve illustrated with respect to the padding (versus rollers) on chute 114 or feed guide 16. Accordingly, Appellant contends that there is no disclosure of a foam padding including a continuous outer layer.

Similarly, Claim 18, dependent from claim 17, further recites that the continuous outer layer is a vinyl layer formed with an anti-microbial agent. Absent a teaching of a vinyl outer layer, the Examiner has urged that it would be an obvious design choice. However, no support for such an assertion is provided, particularly in view of the fact that neither Ross nor the other references in the combination set forth any description of materials for the allegedly similar "sleeve." Nor has the Examiner identified a teaching or suggestion of the use of vinyl incorporating an anti-microbial agent therein as is expressly recited in claim 18. In view of these distinctions, and the failure of the references relied upon, alone or in combination, Appellant respectfully contends that the rejection of claims 16, 17 and 18 should be reversed.

Claims 15 through 19 (5th Question)

Claims 15 through 19 were improperly rejected as being unpatentable under 35 U.S.C. §103(a) over the combination of Boyle (6,309,741) in view JP #6-246841. Boyle does teach the use of a FDA approved closed cell foam padding for use in a shopping cart for the comfort of children or to protect fruits and vegetables from bruising. However, the patent to Boyle clearly teaches

away from the use of any anti-microbial agents, where it states at col. 2, lines 53-55 that “[t]he full skin surface can prevent the infiltration of water, fungus and bacteria and enable the pad to be easily cleaned with soap, steam or disinfectants” (Col 2 line 54-56). What motivation would there be to include antimicrobial agents in a pad that is expressly described as being cleanable with various disinfecting methods (soap, steam, disinfectant)? Moreover, Boyle is clearly directed to a “pad with a tough protective skin...” (Col. 2, lines 53-53). Boyle further goes on to say that cleaning is necessary to remove urine stains and fecal matter from a child. (Col 2 line 59). Conversely, the present invention, directed to a produce handling machine, requires a stationary vegetative produce-contacting surface with an anti-microbial agent formed in padding on the surface.

Furthermore, the Examiner has incorrectly characterized the foam material described in JP Abstract #6246841, and has ignored the fact that it must be a thin, open-cell foam so as to be suitable as an air filter as described in the abstract (“dust collecting materials in cleaners, refrigerators, etc.”), or to receive the post-formation treatment. The Examiner provides no support for the assertion that one skilled in the art would be motivated to modify an FDA-approved pad material of Boyle with the agents set forth in JP Abstract to render the pad more sanitary. Nor has the Examiner identified how Boyle’s closed-cell foam with a protective skin would be susceptible to treatment or use in the manner set forth in JP Abstract. Absent such teachings, Appellant respectfully urges that the proposed combination is, therefore, unsupported by the teachings of the references themselves and improper.

Alternatively, even if the combination is considered, *in arguendo*, it fails to teach all of the limitations of the claims as set forth. In particular, there is no teaching of a vegetative produce handling machine having a stationary surface with a padding thereon, where the “foam padding is formed with an anti-microbial agent (claim 15, emphasis added). In light of the failure of the proposed combination to teach the various aspects of the dependent claims, Appellant submits that the rejection of claims 15 -19 is improper and should be reversed by the Board.

Claims 1, 6 – 11, 22, 24 and 26 (independently) (6th Question)

Claim 1

Claims 1 and 6-11, 22, 24 and 26 were rejected 35 U.S.C. §103(a) over the combination of Moore (2,195,371) in view of Ross (3,651,922) and further in view of EITHER Zabron (5,906,269) OR JP6-246841. Moore teaches a potato washing and drying machine, however, Moore lacks any teaching or suggestion for the use of padding to prevent bruising on elements within the apparatus. Furthermore, Moore does not teach or suggest a concern relative to bruising or contamination from microbes, bacteria or the like.

Ross, as previously noted, does contain a reference to a cushion, however, there is no teaching as to the construction, operability and characteristics of such a cushion. Ross also lacks any suggestion of the use of anti-microbial padding on stationary surfaces.

Zabron, as discussed in detail previously, only teaches the use of antimicrobial agents in a conveyor belt or belting material that is in contact with food. Zabron does not teach or even suggest the use of an antimicrobial agent in any other aspect.

This rejection is set forth at pages 6 – 7 of the Office Action, however, while there is a listing of what is allegedly taught by each of the cited documents, there is no statement as to what information is relied upon in such documents to suggest the combinations and modifications proposed. Not only does Appellant respectfully urge that no basis for the proposed combination or modification is provided, but Appellant can only conclude in light of such omissions, that it is his own application (claims) that have been used as a “recipe” for the hindsight reconstruction of the invention from unrelated teachings in various documents. A piecemeal reconstruction of the prior art patents in light of the claims is not a basis for a holding of obviousness, *In re Kamm et al.*, 172 USPQ 298 (CCPA, 1972). The mere fact that the prior art devices could have been modified does not make the modification obvious unless the prior art suggested the desirability of such a modification, *In re Gordon*, 221 USPQ 1125, (Fed. Cir., 1984); *Jones v. Hardy*, 220 USPQ 1021, (Fed. Cir. 1984).

Although it is urged to be obvious to combine the conveyor belt of Zabron within the teachings of Moore and Ross, at most such a combination would result in one of ordinary skill in the art substituting the belting material taught by Zabron for the conveyor belts taught by Moore or Ross. There is no teaching or suggestion in Zabron, Moore or Ross, that would lead one to use foam padding having antimicrobial agents therein on the stationary surfaces of produce handling apparatus as recited in claim 1. To urge such an expansion is to improperly extend the teaching of the respective references (*e.g. In re Gordon*). At page 7, line 16 of the Final Office Action, the Examiner has asserted that "one would deem it obvious" (not the standard of obviousness) and that "[i]n fact, it would not make sense to provide it to just one surface." That is, however, exactly what Zabron teaches – the use of the antimicrobial in polymeric elastomers - no more, no less, just on the double scrim, woven conveyor belting. Accordingly, Appellant maintains that no basis for the modification of the Moore and Ross apparatus has been provided, so as to establish *prima facie* obviousness, and in any event claim 1 is urged to be patentably distinguishable over the arguable combination of Moore in view of Ross and Zabron.

Relative to an alternative combination of Moore, Ross and JP Abstract, Appellant respectfully incorporates the distinctions and arguments in traversal of the rejection of claim 1 above. Appellant further urges, however, that the Examiner has again failed to set forth a basis for the combination, particularly in light of a lack of teaching in JP Abstract of the use of the material in a food-contacting manner. Appellant notes, as previously stated, that the suggestion of use in a refrigerator was clearly as a dust collector and not as a padding or otherwise in contact with food.

Claim 6

Appellant respectfully contends that dependent claims 6 – 11 are also patentably distinguishable and were improperly rejected for the reasons discussed above relative to claim 1. As to claim 6, which recites padding of closed-cell foam, Appellant urges that the requirement for the live rollers for

“rapid resilient recovery” (col. 3, line 9) is not a requirement of padding and would not suggest such a modification. Absent a teaching or suggestion of the use of a closed cell foam for padding in the references relied upon, Appellant urges that the rejection of claim 6 is improper and should be reversed.

Claims 7 and 8

Claims 7 and 8 recite that the foam padding includes a flexible (vinyl) outer layer to reduce absorption of moisture. Such a limitation is not taught or suggested by a removable wear sleeve affixed to a roller, as taught by Ross. Moreover, the Examiner was asked to provide support for such an assertion, yet it does not appear that such support was identified to Appellant. Accordingly, Appellant respectfully requests that the Board reverse the rejection with respect to claims 7 and 8.

Claim 9

Claim 9, in addition to reciting an inspection conveyor, recites conveyor rolls including “at least an outer layer of foam having anti-microbial properties.” No teaching or suggestion of such a roller configuration is found in the wood rolls of Moore, nor would it have been obvious to modify the wood rolls of Moore with foam rollers of Ross as the Ross rollers are directed to a live roller conveyor with opposing rollers that would preclude any inspection, let alone culling by the inspectors as taught by Moore. Again, the lack of teaching or suggestion of the combination or proposed modification suggests that *prima facie* obviousness has not been established. Moreover, the lack of a specific teaching of an outer layer of foam having anti-microbial properties in any of the references precludes a combination from resulting in the asserted teaching. Here again, the Board is respectfully requested to reverse the rejection relative to claim 9.

Claims 10 and 11

Further considering claim 10, Appellant urges that a “discharge chute 89” as taught by Moore does not give rise to the recited sizer with a drop surface having anti-microbial padding thereon. With respect to claim 11, the standard for obviousness is respectfully urged to be improperly characterized as “could

be," (Final Action, page 7, lines 11-12). Moreover, Appellant's request that the Examiner identify where a packing table (see e.g., Fig. 1, 140A) having a drop surface covered with padding produced with an anti-microbial agent is taught remain outstanding. In light of the various distinctions noted above, and the lack of a specific teaching of the recited limitations, The Board is earnestly solicited to reverse the rejection of claims 10 and 11.

Claims 22 and 24

Claims 22 and 24 each set forth a specific limitation relative to the type of material to be employed as the antimicrobial agent. In the Final Office Action, the rejection was based upon the combination of Moore (2,195,371) in view of Ross (3,651,922) and further in view of EITHER Zabron (5,906,269) OR JP6-246841. However, the rejection of claims 22 and 24 did not identify a specific teaching of the type or particular agent set forth in claims 22 or 24. Rather, the unsupported assertion that the agents claimed were well-known materials was the basis for the rejection of these claims (Final Action, page 7, lines 20-22). Appellant maintains that such a rejection fails to establish *prima facie* obviousness to which Appellant can or must respond. Accordingly, the Board is respectfully requested to reverse the rejection of claims 22 and 24.

Claim 26

In claim 26, Appellant sets forth a limitation as to the nature of the thickness of a foam pad as recited in claim 1. Without factual basis, and ignoring any relationship to cost or operability, the Examiner urges, "the thicker the better." However, Appellant sets forth a specific lower limit of the thickness (see Specification page 9) that would be believed to be operable with respect to the various embodiments depicted. Absent a teaching of the range of thicknesses, Appellant respectfully urges that *prima facie* obviousness has not been established, and requests that the Board overturn the rejection of claim 26.

Claim 12 (7th Question)

The next question presented was whether claim 12 was properly rejected as being unpatentable under 35 U.S.C. §103(a) over the combination of Moore

(2,195,371) in view of Ross (3,651,922) and further in view of EITHER Zabron (5,906,269) OR JP6-246841 and further in view of Kurtz (3,242,008). The various arguments relative to the teachings of Moore, Ross, Zabron and the JP Abstract are incorporated herein by reference. The teachings of Kurtz generally involve the washing and drying of eggs and more specifically a means to remove the water from the shell of the egg. In addition to the above-noted distinctions within claim 1 and failure to teach or suggest the use of an anti-microbial agent, there is also no suggestion for the proposed combination of utilizing a drape in the Moore, Ross or even Zabron references. It is incumbent, in setting forth a *prima facie* obviousness rejection under 35 U.S.C. §103(a) to show where the proposed teaching or suggestion for a combination or modification is found in the cited references.

In addition, even if the proposed modification to add the Kurtz curtain to the Moore washer is appropriate, in other words considering Moore in view of Ross and further in view of EITHER Zabron OR JP6-246841 and further in view of Kurtz *in arguendo*, there remains no teaching or suggestion to make such a curtain with an anti-microbial agent as specifically recited in claim 12. Accordingly, the only possible conclusion is that Appellant's disclosure is again being used as a recipe for selecting portions of the prior art to construct the claimed invention. It is clear that the combination of patents does not suggest that the modifications urged by the Examiner be made. Absent such, *prima facie* obvious has not been established. Accordingly, claim 12 is urged to be allowable and the Board is respectfully requested to reverse the rejection thereof.

Claim 13 (8th Question)

Claim 13 is improperly rejected as unpatentable under 35 U.S.C. §103(a) over the combination of Moore (2,195,371) in view of Ross (3,651,922) and further in view of EITHER Zabron (5,906,269) OR JP6-246841 and further in view of Bowman (2,012,655). The arguments and discussion set forth above relative to claim 1 are incorporated herein by reference. Claim 13, dependent from claim 1, further recites that the vegetative produce washer further comprises "scrubber rubber produced with an anti-microbial agent to provide resistance

to the growth of microbes thereon.” The patent to Bowman teaches the use of rubber spurs (5) to dislodge scale on the surface of certain fruits. Bowman is notably lacking any reference to washing with the use of water, nor is there any suggestion that microbial contamination of the Bowman equipment is a problem. Accordingly there would be no reasonable expectation that Bowman or another reviewing Bowman would have motivation to utilize a washer with a scrubber rubber produced with an anti-microbial agent, as recited. Again, Appellant sought the basis for such a modification, and it appears that the Examiner continued to rely on the teachings of Zabron as extending to the particular construction and materials of the recited scrubber rubber. Here again, it appears that Appellant’s disclosure and claims were used as the “recipe” by which a piecemeal reconstruction of the claimed invention was conducted in hindsight. As the courts have said, this is not the standard for obviousness, and Appellant respectfully submits that the rejection of claim 13 is appropriately reversed.

Claim 14 (9th Question)

Considering claim 14, which was rejected under 35 U.S.C. §103(a) over the combination of Moore (2,195,371) in view of Ross (3,651,922) and further in view of EITHER Zabron (5,906,269) OR JP6-246841 and further in view of Butterworth (3,449,779), the patent to Butterworth, as in the Bowman reference above, uses an abrasive action so as to scrape foreign material from an egg shell. Such a combination or modification does not give rise to the recited limitation of a brush within a vegetative produce washer, nor of the further limitation of the brush having bristles produced with an anti-microbial agent. Moreover, to apply the teachings of Zabron to materials other than the belting is, as set forth above, both a hindsight reconstruction unsupported by the references and an improper expansion of the scope of what is taught by Zabron. No reference relied upon in the combination suggests the use of brush bristles with an anti-microbial agent. The Examiner appears to seek to “bolster” his position in the rejection of claim 14 by further asserting a Dupont document (cited in the present application and noted in Appellant’s information disclosure), but has not made this document a basis for the rejection.

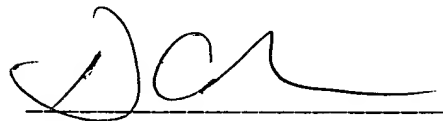
Once again, the mere fact that the cited prior art (Moore in view of Ross, Zabron / JP Abstract and Butterworth) could have been combined does not make the combination and the required modification (modification to the brushes 20 / bristles of Butterworth) obvious unless the prior art suggested the desirability of such a combination. Appellant respectfully urges that the rejection is therefore improper and respectfully requests that the Board reverse the rejection of claim 14.

Claims 2 – 5, 23 and 25 (10th Question)

Claims 2-5 are rejected as being unpatentable under 35 U.S.C. §103(a) over the combination of Moore (2,195,371) in view of Ross (3,651,922) and further in view of EITHER Zabron (5,906,269) OR JP6-246841 and further in view of Newhall (2,534,205). Appellant respectfully incorporates herein the previously noted distinctions between claim 1, from which claims 2 - 5 depend, and the combination of Moore in view of Ross and Zabron or JP Abstract 6-246841. Newhall is added to the arguable combination for its teachings relative to the structure of a water absorber having open-cell foam rollers and associated wringer rollers. However, the Examiner has failed to establish where, if at all, the various combinations of patents, alone or in combination, teach the use of a water absorber with an open cell foam roller having anti-microbial properties. The simple substitution of Newhall's water absorber for the dryer of Moore does not result in any teaching or suggestion of rollers with the characteristics recited in claims 2 - 5. As to the antibacterial properties, the Examiner improperly extends the teaching of the Zabron conveyor belt or the JP abstract disclosure of foam for padding/dust collection (neither of which teach a water absorbing property) as the basis for the modification of Newhall. Hence, the Appellant urges that claims 2 – 5 are improperly rejected and requests that the Board reverse this rejection as well.

In light of the various arguments set forth above, Appellant respectfully submits that all of the question presented should be answered in the negative, that all rejections set forth should be reversed, and that Appellant's pending claims should be indicated as allowable.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'DCB', is written over a horizontal line.

Duane C. Basch

Attorney for Appellant

Registration No. 34,545

Basch & Nickerson LLP
1777 Penfield Road
Penfield, New York 14526

DCB/dcb

8. CLAIMS APPENDIX:

The following are the appealed claims:

1. (previously presented) A vegetative produce handling machine, comprising:

a vegetative produce receiver having a generally horizontal receiving surface and at least two opposing sides adjacent thereto to retain vegetative produce on the receiving surface;

a vegetative produce washer, adjacent the vegetative produce receiver, for washing the vegetative produce as it is transported therethrough;

a water absorber, adjacent said vegetative produce washer, for movably supporting the vegetative produce and to remove excess water from the vegetative produce as it exits the washer; and

a foam padding covering at least one stationary vegetative produce-contacting surface of the machine, wherein said foam padding is intended to reduce bruising of the vegetative produce and where said foam padding is formed with an anti-microbial agent to retard the growth of microbes within the padding.

2. (previously presented) The machine of claim 1, wherein said water absorber includes a plurality of donut-style rolls for supporting the vegetative produce and absorbing moisture therefrom, and where said rolls are manufactured from an open-cell foam that has anti-microbial properties.

3. (previously presented) The machine of claim 2, wherein the anti-microbial properties of the open-cell foam are achieved by adding an anti-microbial agent during the manufacture of the foam.

4. (previously presented) The machine of claim 3, wherein the open-cell foam is a latex foam suitable for operating in a moist environment.



5. (previously presented) The machine of claim 2, further comprising a plurality of wringer rolls, located in contact with the donut-style rolls, to compress the open-cell foam and thereby eliminate water attracted to surfaces within the open-cell foam.

6. (previously presented) The machine of claim 1, wherein the foam padding covering at least one vegetative produce-contacting surface of the machine, is a closed-cell foam.

7. (previously presented) The machine of claim 1, wherein the foam padding covering at least one vegetative produce-contacting surface of the machine further includes a flexible outer layer of vinyl to reduce the absorption of moisture by the foam padding.

8. (previously presented) The machine of claim 7, wherein the flexible outer layer of vinyl is formed with an anti-microbial agent to retard the growth of microbes on moist, exposed surfaces thereof.

9. (previously presented) The machine of claim 1, further comprising a roller inspection conveyor for transporting the vegetative produce while turning it for inspection, wherein the inspection conveyor includes a plurality of parallel conveyor rolls and where said conveyor rolls include at least an outer layer of foam having anti-microbial properties.

10. (original) The machine of claim 1, further comprising a sizer, wherein the sizer has at least one drop surface that is covered with padding and where the padding is produced with an anti-microbial agent to provide resistance to the growth of microbes thereon.

11. (original) The machine of claim 1, further comprising packing table wherein the packing table has at least one surface that is covered with padding and where the padding is produced with an anti-microbial agent to provide resistance to the growth of microbes thereon.

12. (original) The machine of claim 1, further comprising a drape produced with an anti-microbial agent to provide resistance to the growth of microbes thereon.

13. (previously presented) The machine of claim 1, wherein said vegetative produce washer further comprises scrubber rubber produced with an anti-microbial agent to provide resistance to the growth of microbes thereon.

14. (previously presented) The machine of claim 1, further comprising a brush within the vegetative produce washer, wherein the brush has bristles produced with an anti-microbial agent to provide resistance to the growth of microbes thereon.

15. (previously presented) A vegetative produce handling machine, comprising:

at least one stationary vegetative produce-contacting surface; and

a foam padding covering at least a portion of said stationary vegetative produce-contacting surface of the machine, wherein said foam padding is intended to reduce bruising of the vegetative produce contacting the stationary surface and where said foam padding is formed with an anti-microbial agent to retard the growth of microbes on the padding.

16. (previously presented) The vegetative produce handling machine of claim 15, wherein the foam padding is a closed-cell foam.

17. (original) The machine of claim 15, wherein the foam padding further includes a continuous yet flexible outer layer.

18. (previously presented) The machine of claim 17, wherein the flexible outer layer comprises a vinyl compound formed with an anti-microbial agent to retard the growth of microbes on surfaces coming in contact with the vegetative produce.

19. (original) The machine of claim 15, wherein said foam padding is molded to shape.

20. (canceled)

21. (canceled)

22. (previously presented) The machine of claim 1, wherein the anti-microbial agent is Tributyltin Maleate.

23. (previously presented) The machine of claim 3, wherein the anti-microbial agent used in the open-cell foam of said donut-style rolls is Tributyltin Maleate.

24. (previously presented) The machine of claim 1, wherein the anti-microbial agent is an antimicrobial compound, with an active ingredient of silver.

25. (previously presented) The machine of claim 3, wherein the anti-microbial agent used in the open-cell foam of said donut-style rolls is an antimicrobial compound, with an active ingredient of silver.

26. (previously presented) The machine of claim 1, wherein said foam padding is at least 0.125 inches thick.

9. **EVIDENCE APPENDIX:**

NONE

10. RELATED PROCEEDINGS APPENDIX:

NONE